

**Notice of Allowability**

Application No.

09/759,748

Examiner

Ashwin Mehta

Applicant(s)

BENSON, DAVID L.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to papers submitted 15 October 2003.
2. ☒ The allowed claim(s) is/are 1-4 and 44-72.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All   b) ☐ Some\*   c) ☐ None   of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- \* Certified copies not received: \_\_\_\_\_.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
  - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No. \_\_\_\_\_.
  - (b) ☐ including changes required by the proposed drawing correction filed \_\_\_\_\_, which has been approved by the Examiner.
  - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the margin according to 37 CFR 1.121(d).

9. ☒ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |   |  |
|---|--|
| 1 <input type="checkbox"/> Notice of References Cited (PTO-892)   | 5 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                     |
| 2 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                               | 6 <input checked="" type="checkbox"/> Interview Summary (PTO-413), Paper No. <u>attached</u> . |
| 3 <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No. _____             | 7 <input checked="" type="checkbox"/> Examiner's Amendment/Comment                             |
| 4 <input checked="" type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8 <input type="checkbox"/> Examiner's Statement of Reasons for Allowance                       |
|   | 9 <input type="checkbox"/> Other   |

***Specification***

1. The objection to the specification is withdrawn, in light of Applicant's assurance that the ATCC deposit numbers will be inserted into page 7 of the specification upon receipt of a notice of allowability.

***Claim Objections and Rejections***

2. The rejections of claims 6, 8-19, and 21-43 under 35 U.S.C. 112, 1<sup>st</sup> and/or 2<sup>nd</sup> paragraphs and/or 35 U.S.C. 102/103, are withdrawn in light of the claim cancellations.

***Examiner's Amendment***

3. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Lila Ackrad on December 18, 2003.

In the claims:

1. Seed of hybrid maize variety [Hybrid maize seed] designated 33R77, representative seed of said variety [hybrid 33R77] having been deposited under ATCC Accession number \_\_\_\_\_.

In claim 47, lines 2-3, the recitation, "wherein said plant is capable of expressing" was replaced with, --said plant having--.

In claim 64, line 1, the recitation, "capable of expressing" was replaced with, --having--.

In claim 65, line 14, "the" was deleted, and the recitation, "of backcrossing to said inbred maize parent plant" was replaced with --(c) and (d)--.

In claim 65, line 16, --fourth or higher-- was inserted after "said".

In claim 70, line 14, "the" was deleted, and the recitation, "of backcrossing to said inbred maize parent plant" was replaced with --(c) and (d)--.

In claim 70, line 16, --fourth or higher-- was inserted after "said".

3. Claims 1-4 and 44-72 are allowed.

#### **REQUIREMENT OF ALLOWANCE UNDER 37 CFR §§ 1.801-1.809**

4. The deposit statements in the specification on pages 7 and 49 are deemed in accordance with 37 CFR §§ 1.801-1.809. Therefore, no 35 USC § 112, 1<sup>st</sup> paragraph rejection has been maintained even though it is apparent that seed of hybrid maize 33R77 and seed of inbred maize varieties GE515419 and GE567914 are essential to the claimed invention and that their deposit is necessary for an adequate written description and enablement for the claimed invention. Since the application is otherwise in condition for allowance except for the needed deposit of 33R77, GE515419, and GE567914 seed, and since the Office has received written assurance that an

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acceptable deposit will be made on or before payment of the issue fee, the Office is authorized to mail Applicant a Notice of Allowance and Issue Fee Due together with a requirement that the needed deposit be made within THREE (3) MONTHS of the mail date of this letter (see 37 CFR§ 1.809(c)).

Under 37 CFR 1.809(c)(d) an applicant is required to make a deposit of seed within three months after the mailing date of the Notice Of Allowance and Issue Fee Due. The time period for making a biological deposit, and an amendment to add the depository information to the specification, is no longer extendable. See 37 CFR 1.136(c) and 1.809(c), revised in Changes to the Time Period for Making any Necessary Deposit of Biological Material, 66 Fed. Reg. 21090 (April 27, 2001), 1246 Off. Gaz. Pat. Office 104 (May 22, 2001), effective for Notices of Allowability mailed on or after May 29, 2001. Amendments are no longer permitted to be filed after the payment of the issue fee. See 37 CFR 1.312, revised in Changes to Application Examination and Provisional Application Practice, 65 Fed. Rge. 14865, 14869 and 14873 (March 20, 2000), 1233 Off. Gaz. Pat. Office 47, 50 and 54 (April 11, 2000), effective on May 29, 2000. Failure to make the needed deposit of seeds of 33R77, GE515419, and GE567914 will result in abandonment of the application for failure to prosecute. The deposit statements on pages 7 and 49 in the specification, and all claims which refer to the instant seeds by name, must be amended to include the deposit accession numbers. These amendments should be submitted before the payment of the issue fee as an Amendment After Allowance under 37 CFR 1.312. The statement of deposit in the specification shall contain:

- (1) The accession number for the deposit(s);

- (2) The date of the deposit(s);
- (3) A description of the deposited biological material sufficient to specifically identify and to permit examination; and
- (4) The name and address of the depository. (See 37 CFR 1.809(d)).

***Contact Information***

Any inquiry concerning this or earlier communications from the examiner should be directed to Ashwin Mehta, whose telephone number is 703-306-4540. The examiner can normally be reached on Mondays-Thursdays and alternate Fridays from 8:00 A.M to 5:30 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached at 703-306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 and 703-872-9306 for regular communications and 703-872-9307 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

December 18, 2003



Ashwin D. Mehta, Ph.D.  
Primary Examiner  
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